



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/665,786	09/20/2000	Akihiro Morohashi	277881US6	6137

22850 7590 04/05/2006

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

TRAN, THANG V

ART UNIT PAPER NUMBER

2627

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/665,786

Applicant(s)

MOROHASHI, AKIHIRO

Examiner

Thang V. Tran

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-23 and 25 is/are rejected.
- 7) ☒ Claim(s) 12 and 24 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

The communication dated 2/16/06 has been considered with the following results:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3, 10, 11, 13, 15, 22, 23 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Arisaka et al (JP 06006495 A).

Regarding claims 1, 13 and 25, see Fig. 3 and an abstract of Arisaka et al which show a communication system comprising: first apparatus (20) which is portable and inherently has a reproducing means for reproducing data from a first storage medium (24); and a second apparatus (10) for transmitting data to the first apparatus (20), wherein the second apparatus (30) having a second storage medium (14) for storing management information (file list) of data to be transferred to the first storage medium; a communication means (30) for communicating data with the first apparatus; edit means (20, 22) capable of editing the management information (selected file from file list); and control means (10,12) for controlling transfer of data stored in the second storage medium in the second apparatus (10) to the first storage medium (24) in the first apparatus by way of the communication means based on the information (selected file) edited (selected) by the editing means (see Fig. 3).

Regarding claims 3 and 15, see display 22 in Fig. 3 which inherently includes a window for displaying identification information (file list) based on the management information stored in the second medium, and a window for displaying identification information (selected files) based on the management information of the data to be transferred to the first medium.

Regarding claims 10 and 22, limitations in these claims must be inherently included in Fig. 3; otherwise, data stored in the second storage medium (14) cannot be transferred to the first storage medium (24) by way of the communication means (30).

Regarding claims 11 and 23, limitations in these claims must be inherently included in Fig. 3; otherwise, data stored in the second storage medium (14) cannot be transferred to the first storage medium (24) by way of the communication means (30) if the connector 13 or 23 of Fig. 3 is not connected.

3. Claims 1, 13, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsutsui et al (US 6,668,158).

Tsutsui et al., according to Figs. 1-21, show a control system comprising all the limitation as recited in the instant claimed invention as interpreted below.

Regarding claims 1, 13 and 25, see Fig. 1, which show a communication system comprising: a first apparatus (13) which is a portable device (see column 6, lines 47-55 which listed a number of kinds of portable devices) and inherently has a reproducing means for reproducing data from a first storage medium (CD in storage 13); and a second apparatus (6-9) for transmitting data (music) to the first apparatus, wherein the second apparatus (30) having a second storage medium for storing management information (titles of music) of data (music) to be transferred to the first storage medium; a communication means (2, 4, 5) for communicating

Art Unit: 2627

data with the first apparatus; edit means (see Fig. 2) capable of editing the management information (select titles of music); and control means (1,11,12) for controlling transfer of data stored in a second storage medium in the second apparatus to the first storage medium in the first apparatus (13) by way of the communication means (2, 4, 5) based on the information (titles) edited (selected) by the editing means.

4. Claims 1-11, 13-23 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Arai (US 6,714,920).

Arai, according to Figs. 1-8, show an information processing apparatus comprising all the limitation as recited in the instant claimed invention as interpreted below.

Regarding claims 1, 13 and 25, see Fig. 1, which show a communication system comprising: a first apparatus (3) which is a portable device (see column 6, lines 47-55 which listed a number of kinds of portable devices) and has a reproducing means (see column 21, lines 60-65) for reproducing data from a first storage medium (memory 305); and a second apparatus (1) for transmitting data to the first apparatus (3), wherein the second apparatus (1) having a second storage medium (102) for storing management information (list of titles as example) of data (music or movie) to be transferred to the first storage medium; a communication means (4-6) for communicating data with the first apparatus; edit means (2) capable of editing the management information (select titles of music or movie); and control means (1,2) for controlling transfer of data stored in a second storage medium in the second apparatus to the first storage medium in the first apparatus (3) by way of the communication means (4-6) based on the information (titles) edited (selected) by the editing means.

Regarding claim 2 and 14, see Fig. 8 which discloses that the editing is performed by unit 2; therefore, regardless whether the communication between the first apparatus (portable unit 3) and the second apparatus is established, the edit means (2) is still capable of editing the management data (selecting titles of music or movies) as recited in these claims.

Regarding claims 3 and 15, see display 202 in Fig. 1 which inherently includes a window for displaying identification information (list of titles) based on the management information stored in the second medium, and a window for displaying identification information (selected titles) based on the management information of the data to be transferred to the first medium. Note: see Figs. 8A and 8B also.

Regarding claims 4-11 and 16-23 see respective disclosure of Figs. 3-7 for the limitations as recited in these claims.

Allowable Subject Matter

5. Claims 12 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 12 and 24 are allowable over the prior art of record because the prior art of record considered in combination or individually, fails to suggest or fairly teach a communication system including all limitations as recited in each of claims 12 and 24.

Cited references

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references relate to an apparatus for controlling and transferring information from one apparatus to another apparatus based on edited data.

Art Unit: 2627

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thang V. Tran whose telephone number is (571) 272-7595. The examiner can normally be reached on M-F 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nguyen Hoa can be reached on (571) 272-7579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thang V. Tran
Primary Examiner
Art Unit 2627